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IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL  
AND APPEAL BOARD

In the matter of  
Trademark Application Serial No. 76/277,251  
Filed: June 25, 2001  
Published: October 29, 2002  
Mark: INFOSIL

INTERSIL AMERICAS INC.,

Opposer,

vs.

INFOSIL, Inc.

Applicant.

Opposition No. \_\_\_\_

03-28-2003

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NOTICE OF OPPOSITION

Opposer, Intersil Americas Inc., a Delaware corporation having a  
principal place of business at 2401 Palm Bay Road, N.E., Palm Bay, FL 32905,  
believes it will be damaged by registration of the mark shown in Application

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Serial Number 76/277,251 and hereby opposes that application, alleging as grounds for its opposition that:

1. As is evidenced by the publication of the mark INFOSIL in the October 29, 2002 issue of the Official Gazette, Applicant, Infosil, Inc., seeks to register the mark INFOSIL as a trademark in International Class 9 for "Computer hardware, computer chips; networking computer chips; chips for routers, switches, gateways and storage controllers and associated firmware and software for next generation enterprise, namely, telecom infrastructure which improves performance, bandwidth, security and management of storage area networks, local area networks, metro area networks and wide area networks." Applicant's intent-to-use application for the mark INFOSIL was filed on June 25, 2001.

2. Opposer owns exclusive rights in the INTERSIL mark, as well as applications and registrations for the INTERSIL and INTERSIL and Design marks filed in the United States and foreign jurisdictions. Those applications and registrations include:

a. U.S. trademark registration for INTERSIL, U.S. reg. no. 2,488,585, which issued on September 11, 2001, for the following goods in International Class 9:

semiconductors; integrated circuits, namely, circuits containing transistors or other semiconductor devices used in circuits for computers, wired and wireless communications, electronic networks, digital and analog electronic circuits, microprocessors, microcontrollers, digital signal processors, programmable logic circuits, memory circuits, power control circuits, amplifiers and power converters, analog and digital converters; power semiconductors, namely, MOSFETs and diode arrays; electronic circuit boards and assembled electronic modules containing said integrated circuits and power telecommunication devices; circuit boards for telephones,

wireless communication, radio, television and telephone transmission and reception, data recording and storage media; computer software, namely, utility programs for use with the above goods, and application software for enabling transmission, reception, recording and storage of data transmitted over telephones; wireless communication, radio, television and telephone transmission and reception, data recording and storage media; computer software for use in the manufacture of semiconductors, namely, for process, control, yield enhancement, as well as process and circuit design; electronic components, namely, hybrid electronic circuits, circuit boards, integrated circuit packages, and lead frames used in manufacturing semiconductors, and user manuals sold with the above goods; and

b. U.S. trademark registration number 2,534,606, which issued on January 29, 2002, for INTERSIL and Design in International Class 9 for the following goods:

semiconductors; integrated circuits, namely, circuits containing transistors or other semiconductor devices used in circuits for computers, wired and wireless communications, electronic networks, digital and analog electronic circuits, microprocessors, microcontrollers, digital signal processors, programmable logic circuits, memory circuits, power control circuits, amplifiers and power converters, analog and digital converters; power semiconductors, namely, MOSFETs and diode arrays; electronic circuit boards and assembled electronic modules containing said integrated circuits and power telecommunication devices; circuit boards for telephones, wireless communication, radio, television and telephone transmission and reception, data recording and storage media; computer software, namely, utility programs for use with the above goods, and application software for enabling transmission, reception, recording and storage of data transmitted over telephones; wireless communication, radio, television and telephone transmission and reception, data recording and storage media; computer software for use in the manufacture of semiconductors, namely, for process, control, yield enhancement, as well as process and circuit design; electronic components, namely, hybrid electronic circuits, circuit boards, integrated circuit packages, and lead

frames used in manufacturing semiconductors, and user manuals sold with the above goods.

Opposer's INTERSIL, and INTERSIL and Design registrations are valid and subsisting, and constitute *prima facie* evidence of Opposer's exclusive right to use the INTERSIL mark in commerce on the goods specified therein. There is no issue as to priority. Opposer's U.S. registration for INTERSIL in class 9, registration number 2,488,585, issued on September 11, 2001. Opposer's U.S. registration for the mark, INTERSIL and Design, registration number 2,534,606, also for class 9 goods, issued on January 29, 2002. Opposer has been using the INTERSIL and INTERSIL and Design marks for years. Applicant has yet to use the INFOSIL mark in commerce.

In view of the similarity of the respective marks, and the directly competitive and highly-related nature of the goods of the respective parties, it is alleged that Applicant's INFOSIL mark so resembles Opposer's registered INTERSIL mark as to be likely to cause confusion or mistake or to deceive, to dilute the value and source identifying power of Opposer's INTERSIL identifier, and to disparage and falsely suggest a connection with Opposer, thereby causing loss, damage, and injury to Opposer and the purchasing public.

3. Opposer is in the business of manufacturing, marketing and selling throughout the United States and worldwide a wide range of products, including semiconductors and electronic circuitry for use in a wide spectrum of products and applications, including computers, telecommunications products and wireless technology. Opposer has offered, throughout the United States, electronic devices, including semiconductors, transistors, hybrids, and integrated circuits and has marketed these goods in connection with the INTERSIL mark. As a consequence of Opposer's extensive marketing,

promotion, advertising, and sales activity, Opposer's INTERSIL mark has become well-known as identifying Opposer's goods, and as a result, the INTERSIL mark has become a valuable asset of Opposer and the principal symbol of its extensive goodwill.

Applicant's INFOSIL mark is confusingly similar to Opposer's INTERSIL mark, resembling it in sound, appearance and commercial impression. The goods to which Opposer's mark pertains and the goods with which Applicant proposes to use its mark are directly competitive and highly-related, and will be marketed, distributed and rendered in the same industries.

In view of the similarity of the respective marks and the directly competitive and highly-related nature of the goods of the respective parties, it is alleged that Applicant's INFOSIL mark so resembles Opposer's INTERSIL mark previously used in the United States, and not abandoned, as to be likely to cause confusion or mistake or to deceive, to dilute the value and source identifying power of Opposer's INTERSIL identifier, and to disparage and falsely suggest a connection with Opposer thereby causing loss, damage, and injury to Opposer and the purchasing public.

4. Applicant's corporate and trade name, INFOSIL, INC. is confusingly similar to Opposer's INTERSIL mark, resembling it in sound, appearance and commercial impression. The goods to which Opposer's INTERSIL mark pertain and the goods which Applicant proposes to offer under the INFOSIL, INC. trade name are directly competitive and highly-related, and will be marketed, distributed and rendered in the same industries. Applicant adopted INFOSIL, INC. as a corporate and trade name well after Opposer began using the INTERSIL mark, and Opposer is informed and believes and on that

basis alleges that such adoption was with the knowledge of Opposer's prior use of INTERSIL.

In view of the similarity of Opposer's mark, INTERSIL, and Applicant's INFOSIL, INC. corporate and trade name, and the directly competitive and highly-related nature of the goods of the respective parties, it is alleged that Applicant's INFOSIL, INC. corporate and trade name so resembles Opposer's INTERSIL mark previously used in the United States, and not abandoned, as to be likely to cause confusion or mistake or to deceive, to dilute the value and source identifying power of Opposer's INTERSIL identifier, and to disparage and falsely suggest a connection with Opposer thereby causing loss, damage, and injury to Opposer and the purchasing public.

5. As a consequence of Opposer's extensive marketing, promotion, advertising and sales activity involving goods under the INTERSIL mark, Opposer's INTERSIL mark has become well known as identifying Opposer's goods, and as a result, the INTERSIL mark has become a valuable asset of Opposer and the principal symbol of its extensive goodwill. Applicant's intended adoption of INFOSIL, a mark virtually identical to Opposer's distinctive mark, INTERSIL, comes long after Opposer has established such fame and extensive goodwill in INTERSIL.

Opposer is informed and believes and on that basis alleges that Applicant intends to adopt INFOSIL as a mark with knowledge of Opposer's prior rights and with the intention of playing off Opposer's mark and unfairly trading upon the goodwill associated with Opposer's prior rights in its mark and the goodwill associated therewith, and thereby causing loss, damage and injury to Opposer and the purchasing public.

6. Through its significant investment of time, energy and resources, Opposer has secured widespread recognition, fame and goodwill in its distinctive name and mark, INTERSIL, throughout the United States. INTERSIL has become famous, known and identified in the minds of the public with a wide array of Opposer's goods, which Opposer markets, distributes and renders in a wide number of industries. The INTERSIL mark serves to distinguish Opposer as the source of goods bearing or rendered in connection with the mark, and serves to indicate the high quality of those goods.

Opposer's longstanding, widespread and continuous use of INTERSIL has earned it a reputation for high quality, and gives it a valid, legal right to continue to use INTERSIL in connection with its goods and services, which right precludes the use of similar marks in a manner that is likely to blur or tarnish, or erode or lessen the capacity of Opposer's INTERSIL mark to identify and distinguish Opposer's goods in the minds of the public, whether by creating negative associations with Opposer's mark or weakening the uniqueness and distinctive significance of Opposer's mark, and its capacity to give customers the assurance of quality and satisfaction they have in knowing they have purchased goods bearing the famous INTERSIL mark.

Applicant's mark is almost identical to, and certainly confusingly similar to Opposer's distinctive, famous INTERSIL mark, resembling it in sound, appearance and commercial impression. Applicant's intended adoption of INFOSIL comes long after Opposer has established such fame and extensive goodwill in INTERSIL. Applicant's use of INFOSIL will blur or tarnish, or erode or lessen the capacity of Opposer's INTERSIL mark to identify and distinguish Opposer's goods in the minds of the public, whether by creating negative associations with Opposer's mark or weakening the mark's uniqueness and


distinctive significance, and its capacity to give customers the assurance of quality and satisfaction they have in knowing they have purchased goods bearing the famous INTERSIL mark, thereby causing loss damage and injury to Opposer and the purchasing public.

WHEREFORE, Opposer prays that this notice of Opposition be sustained, that Applicant's Trademark Application Serial No. 76/277,251 be rejected, and that Applicant be denied registration of INFOSIL as a trademark for the goods specified in that application.

This Notice of Opposition is being submitted in duplicate along with the requisite \$300.00 fee. Please charge any additional fees to our Deposit Account No. 50-0261.

Respectfully submitted,

Date: March 28, 2003



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